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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,156	02/25/2002	Mark Stutler	3152A-Z	9175

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Alexandria, VA 22314

EXAMINER
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CANFIELD, ROBERT

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 03/18/2005

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/081,156  
Filing Date: February 25, 2002  
Appellant(s): STUTLER, MARK

**MAILED**

**MAR 18 2005**

**GROUP 3600**

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Jim Zegeer  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 05/20/04.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying that there are no related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

As noted in the letter of defective brief mailed 10/20/04 the after final amended referenced in the appeal brief had not been received. A duplicate copy of the amendment after final rejection filed on 05/20/04 has been received and entered.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

Issue 1 that the rejections under 112(2) are moot in view of the amendment filed after final rejection is not correct. The amendment after final filed 05/20/04 has been received and an Advisory Action has been mailed. The amendment after final failed to remove the limitation of "thin" from claim 1. The amendment after final failed to remove "thin" from line 5 of claim 16. The amendment after final failed to change "channel member" to - - channel element - - at line 16 of Claim 17. As such, the rejection of Claims 1, 6, 16 and 17 under 112(2) as set forth in paragraph 4 of the final rejection mailed 10/20/03 remains. The rejection under 112(2) of Claim 17 can be easily overcome by amending to provide proper antecedent basis. Similarly, removal of the limitation "thin" from Claims 1 and 16 would overcome the rejection under 112(2) of Claims 1, 6 and 16.

Issue 2 and Issue 3 are correct.

**(7) Grouping of Claims**

Applicant states that the claims stand or fall together.

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record Relied Upon**

5479750	Carlberg	01/1996
5,772,185	Pulsipher	06/1998

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Issue 1: Claims 1, 6, 16 and 17 are rejected under 35 U.S.C. 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Issue 2: Claims 1, 6 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,479,750 to Carlberg.

Issue 3: Claims 1, 6, 13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,772,185 to Pulsipher.

These rejections are set forth in a prior Office Action, mailed on 10/20/03.

**(11) Response to Argument**

**Issue 1:** There is no argument presented that the term “thin” is not a relative term or that the specification provides a standard for ascertaining the scope of the term. The brief only recites that the rejections of claims 1-4, 6 and 15-17 under 35 U.S.C. 112, second paragraph, are rendered moot by the amendment after final filed 05/20/04. While the amendment after final filed 05/20/04 has removed the limitation of “thin” from Claims 2, 15 and 16 (first occurrence), it has failed to remove the limitation from Claim 1 or the second occurrence in Claim 16. Claim 6 depends from Claim 1 and as such is also rendered indefinite by the relative term “thin”. Claim 17 at line 16, should be amended to change “channel member” to - - channel element - - to provide proper antecedent basis.

**Issue 2:** Applicant argues that the cap 10 of Carlberg is not a “thin” plastic channel element. Applicant relies upon a passage at column 4 of Carlberg, which recites that the cap is comprised of a flexible plastic material of “moderate thickness”. It is the examiner’s position that applicant has failed to adequately define the scope of the relative limitation “thin” and that while Carlberg may use the relative term “moderate thickness” one of ordinary skill in the art would recognize the cap 10 of Carlberg as meeting the limitation of a “thin plastic channel element”. Carlberg discloses that the plastic cap 10 must be flexible and resilient which is what is required of the channel element of the instant invention. Since applicant fails to specifically define what is meant or required by “thin” the examiner believes the cap 10 of Carlberg meets the

limitation since it is thin enough to be flexed slightly outward to receive joist 12 in a snug fit (column 4 lines 13-15).

Applicant also argues that the cap of Carlberg is not reusable. This is not found persuasive as the cap 10 inherently may be reused. Further the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant further argues that the device of Carlberg does not protect and reinforce the top layer of a newly laid block or brick wall. It is the examiner's position that all references to the block or brick wall are made with intended use language. Recitations of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The examiner fails to find a structural difference between the rejected claims and the cap 10 of the reference. The cap 10 is quite capable of being applied along the top edge of a course of blocks or bricks. Note that no particularly

block, brick, or wall width is ever specified in the claims and Carlberg recites at the bottom of column 3 that the width dimension of segment 16 may be varied to accommodate two or more joists.

Note that Claim 15 no longer requires the limitation "thin" as applicant states it does on page 6 of the brief. The examiner believes Carlberg to meet the limitation "thin" as noted above.

**Issue 3:** Applicant argues that the cap 10 of Pulsipher is not reusable. This is not found persuasive as the cap 10 inherently may be reused. Further the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

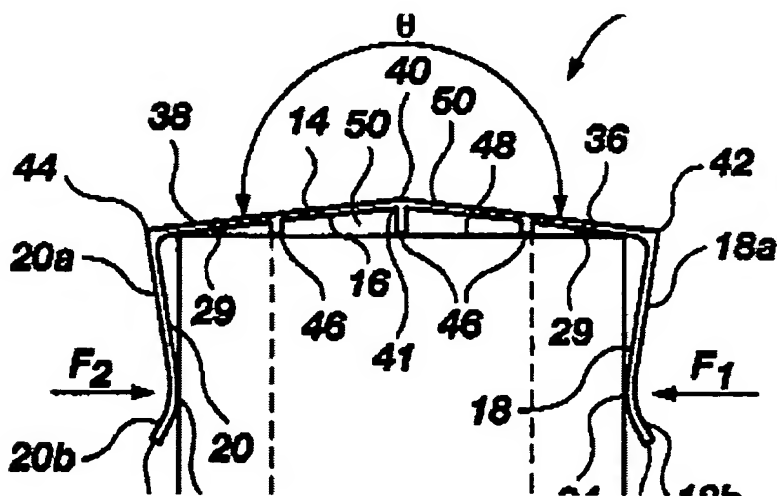
Applicant argues that the device of Pulsipher is not designed to protect and reinforce the top layer of a newly laid block or brick wall. It is the examiner's position that all references to the block or brick wall are made with intended use language. Recitations of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of



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making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The examiner fails to find a structural difference between the rejected claims and the cap 10 of the reference. The cap 10 is quite capable of being applied along the top edge of a course of blocks or bricks as shown in Figure 2. Note that no particular block, brick, or wall width is ever specified in the claims. Pulsipher recites in the background of the invention that the prior art device is impractical for use with brick or cinder walls, which suggests that he is attempting to make a device, which is of practical use with brick or cinder walls.

Applicant argues that Pulsipher fails to provide a top panel member having a smooth, flat inner face adapted to engage a top most surface of a newly laid block or brick wall. This is not found persuasive as the underside of at least one rib 46 provides a smooth, flat inner face adapted to abut the topmost surface of a wall. (column 4, line 60 and Figure 2)



As to claim 13, it is noted that applicant states in the Grouping of the Claims that the claims stand or fall together and fails to provide any reasons why Claim 13 should be considered separately patentable from claims 1 and 15. Applicant argues that steps ( c ) and ( d ) are not provided in Pulsipher. It is the examiner's position that Pulsipher provides all of the structural limitations of the method claim and the steps are inherent steps for engaging the cap 10 to the wall 34 as Pulsipher recites placing the cover onto the top of a wall. It well known when attaching a channel element to an edge with a friction type fit to start by seating one edge and advancing to the opposite edge.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Primary Examiner  
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Robert Canfield  
March 14, 2005

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